



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DWM Oct-05

Paper No. 17

ADAM H. TACHNER
TWO EMBARCADERO CENTER
P.O. BOX 7936
SUITE 2000
SAN FRANCISCO CA 94120-7936

COPY MAILED

OCT 31 2005

OFFICE OF PETITIONS

In re Application of :
Arnaud Pedenon :
Application No. 09/415,018 : ON PETITION
Filed: 7 October, 1999 :
Atty Dckt No. 351891.02300 :

This is a decision on the petition to revive the above-identified application filed on 6 October, 2005, under 37 CFR 1.137(b)¹

¹ Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

which, in light of petitioner's statement that "the Office Action mailed on July 18, 2003 was never received," is first treated as a petition to withdraw the holding of abandonment.

The petitions are **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is not a final agency decision.

The application became abandoned on 16 May, 2003, for failure to timely file a response to the final Office action mailed on 16 January, 2003, which set a three (3) month shortened statutory period for reply. On 20 May, 2003 (certificate of mailing 15 May, 2003), petitioner filed a one (1) month extension of time and an amendment after final rejection. The examiner determined that the amendment did not place the application in *prima facie* condition for allowance, however, and an Advisory Action was mailed on 18 June, 2003. Notice of Abandonment was mailed on 6 October, 2003.

Petitioner's counsel states in the "Reply to Notice of Abandonment" attached to the present petition that "the Office Action mailed on June 18, 2003, was never received by Applicant's or Applicant's attorney."

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

With regard to petitioner's claim that he did not receive the "Office action" mailed on 18 June, 2003 a review of the application file reveals that no Office action was sent on that date. Rather, petitioner appears to be referring to the Advisory Action mailed on 18 June, 2003. Abandonment occurred by operation of law for failure to properly respond to the final Office action mailed on 15 January, 2003.

In this case, petitioner submitted an amendment after final rejection. However, it is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment after a final Office action is filed. The rule clearly indicates that the mere filing of an amendment does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment. Therefore, whether petition received an Advisory Action or not, prior to the expiration of the six month statutory

period, the only right petitioner was entitled to was that of appealing the final rejection, filing a continuing application, or requesting continued examination by filing a submission and the required fee. This application became abandoned for failure on the part of petitioner to file an appeal, a continuing application, or a request for continued examination accompanied by a submission.

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment.²

As such, the petition to withdraw the holding of abandonment is **dismissed**.

PETITION UNDER 37 CFR 1.137(b)

The petition is dismissed because the reply required by 37 CFR 1.137(b)(1) has not been supplied.

As stated above, the only proper reply to a final Office action is (a) a continuing application, (b) a Notice of Appeal, (c) a Request for Continued Examination accompanied by a proper submission, or (d) an amendment which *prima facie* places the application in condition for allowance. As petitioner has not submitted a proper reply, the petition to revive must be **dismissed**.

Petitioner should file a renewed petition accompanied by a proper reply as specified by 37 CFR 1.137(b)(1).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

² See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Application No. 09/415,018

4

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions